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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|---------------------|
| 10/568,507 | 02/16/2006 | Nobuko Yamamoto | 03500.103811. | 1163 |
| 5514 | 7590 | 05/27/2010 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800 | | | | CROW, ROBERT THOMAS |
| ART UNIT | | PAPER NUMBER | | |
| 1634 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/27/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|---|------------------------|---------------------|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) |
| | 10/568,507 | YAMAMOTO, NOBUKO |
| | Examiner | Art Unit |
| | Robert T. Crow | 1634 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires 3 months from the mailing date of the final rejection.
 - b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): _____.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1,9-11 and 22-25.

Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. Other: _____.

/Robert T. Crow/
Primary Examiner, Art Unit 1634

Continuation of 3. NOTE: Applicant's amendments include recitations of an "average sample" (i.e., claim 22) and an "average human" (i.e., claim 25), but Applicant does not provide any citation of support for the amendments. In addition, these new limitation are likely to have issues under 35 USC 112, first paragraph, regarding enablement and/or written description. Further, these new limitations further narrow the scope of the claims, and thus require additional search and consideration because the claims now require these additional limitations. These new limitations were not present at the time of the final rejection, and therefore will not be searched.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's after-final arguments filed 12 May 2010 (hereafter the "Remarks") have been fully considered but they are not persuasive for the reasons discussed below.

A. In response to Applicant's argument on page of the Remarks that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kronick et al also teach the number of spots has the added advantage of allowing the detection signals from the array to be optimized for specific targets (paragraph 0093). Thus, Kronick et al teaches the known technique of having spots for different genes, and that the number of spots differs depending on the genes, and the modification is obvious for the reasons discussed above and in the previous Final Office Action.

In addition, it is also noted that the Supreme Court ruling for *KSR Int'l Co. v. Teleflex, Inc* (No 04-1350 (US 30 April 2007) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See *Ex parte Smith* (USPQ2d, slip op. at 20 (Bd. Pat. App. & Interf. June 25, 2007).

B. Applicant argues on page 5 of the Remarks that the sworn translation of the Japanese priority Application invalidates Kronick et al as prior art.

However, as noted in Section 8 of Form PTO-303, the evidence will not be entered because Applicant has failed to provide a showing of good and sufficient reasons as to why the evidence was not presented earlier. Specifically, the prior art of Kronick et al was previously cited in the non-final action mailed 7 August 2009 and in the Final Action mailed 22 January 2009.

It is noted that the Response above should not be construed as an invitation to file an after final declaration. See MPEP 715.09 [R-3].

/Robert T. Crow/
Primary Examiner, Art Unit 1634